



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/995,515

11/28/2001

Shuqian Jing

00-659-A

1848

20306

7590

03/18/2003

MCDONNELL BOEHNEN HULBERT & BERGHOFF  
300 SOUTH WACKER DRIVE  
SUITE 3200  
CHICAGO, IL 60606

EXAMINER

ANDRES, JANET L

ART UNIT

PAPER NUMBER

1646

DATE MAILED: 03/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/995,515

Applicant(s)

JING, SHUQIAN

Examiner

Janet L. Andres

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-57 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8, 10, 11, 43-45, 50, 56, and 57, drawn to polynucleotides and means of expression, classified in class 435, subclass 69.1, 320.1, and 325, and class 536, subclass 23.5.
- II. Claims 9, 13-17, 38-42, 46, and 47 drawn to polypeptides, classified in class 530, subclass 350.
- III. Claims 12, 51, and 52, drawn to screening methods, classified in class 435, subclasses 6 and 7.1.
- IV. Claims 18-32, 34, 35, and 37, drawn to selective binding agents, classified in class 530, subclasses 388.1 and 389.1.
- V. Claim 33, drawn to a method of treatment using a selective binding agent, classified in class 424, subclass 139.1.
- VI. Claims 36 and 49, drawn to a method of diagnosis using an antibody, classified in class 424, subclass 9.1.
- VII. Claim 48, drawn to methods of treatment with a nucleic acid, classified in class 435, subclass 455.
- VIII. Claim 48, drawn to methods of treatment with a polypeptide, classified in class 514, subclass 2.

Art Unit: 1646

IX. Claims 54 and 55, drawn to transgenic animals and a method of use, classified in class 800, subclass 8.

Claims appear in more than one group if they encompass more than one invention.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the polynucleotides of Invention I and the polypeptides of Invention II differ structurally and functionally, cannot be used together or interchangeably, and have non-coextensive searches and considerations.

Invention I is distinct from Invention III because the polynucleotides have other uses, such as the generation of protein.

Invention I is not related to Invention IV. The polynucleotides of Invention I and the binding agents of Invention IV differ structurally and functionally, cannot be used together or interchangeably, and have non-coextensive searches and considerations.

Invention I is not related to Invention V. The polynucleotides cannot be used in the methods.

Invention I is not related to Invention VI. The polynucleotides cannot be used in the methods.

Invention I is distinct from Invention VII because the polynucleotides have other uses, such as hybridization assays.

Invention I is not related to Invention VIII. The polynucleotides cannot be used in the methods.

Invention I is distinct from Invention IX. The polynucleotides have other uses, such as hybridization assays.

Invention II is not related to Invention III. The polypeptides cannot be used in the screens.

Invention II is not related to Invention IV. The polypeptides of Invention II and the binding agents of Invention IV differ structurally and functionally, cannot be used together or interchangeably, and have non-coextensive searches and considerations.

Invention II is not related to Invention V. The polypeptides cannot be used in the methods.

Invention II is not related to Invention VI. The polypeptides cannot be used in the methods.

Invention II is not related to Invention VII. The polypeptides cannot be used in the methods.

Invention II is distinct from Invention VIII because the polypeptides have other uses, such as the generation of antibodies.

Invention II is not related to the animals of Invention IX. They differ structurally and functionally, cannot be used together or interchangeably, and have non-coextensive searches and considerations.

Invention III is distinct from Invention IV because the binding agents can be identified in other ways, such as by purification.

Art Unit: 1646

Invention III is not related to the methods of treatment of Invention V. The methods require different reagents and different method steps, and have different goals and outcome measures.

Invention III is not related to the methods of detection of Invention VI. The methods require different reagents and different method steps, and have different goals and outcome measures.

Invention III is not related to the methods of treatment of Invention VII. The methods require different reagents and different method steps, and have different goals and outcome measures.

Invention III is not related to the methods of treatment of Invention VIII. The methods require different reagents and different method steps, and have different goals and outcome measures.

Invention III is not related to the animals of Invention IX. The animals cannot be used in the methods.

Invention IV is distinct from the methods of treatment of Invention V because the binding agents have different uses, such as protein purification.

Invention IV is distinct from the methods of detection of Invention VI because the binding agents have different uses, such as protein purification.

Invention IV is not related to the methods of treatment of Invention VII. The binding agents cannot be used in the methods.

Invention IV is not related to the methods of treatment of Invention VIII. The binding agents cannot be used in the methods.

Art Unit: 1646

Invention IV is not related to the animals of Invention IX. They differ structurally and functionally, cannot be used together or interchangeably, and require non-coextensive searches and considerations.

Invention V is distinct from the methods of detection of Invention VI because the methods have different goals and different outcome measures, and require different method steps.

Invention V is not related to the methods of treatment of Invention VII. The methods have different goals and require different reagents and different method steps.

Invention V is not related to the methods of treatment of Invention VIII. The methods have different goals and require different reagents and different method steps.

Invention V is not related to the animals of Invention IX. The animals cannot be used in the methods.

Invention VI is not related to the methods of treatment of Invention VII. The methods have different goals and require different reagents and different method steps.

Invention VI is not related to the methods of treatment of Invention VIII. The methods have different goals and require different reagents and different method steps.

Invention VI is not related to the animals of Invention IX. The animals cannot be used in the methods.

Invention VII is distinct from the methods of treatment of Invention VIII. The methods require different reagents and different method steps.

Invention VII is not related to the animals of Invention IX. The animals cannot be used in the methods.

Invention VIII is not related to the animals of Invention IX. The animals cannot be used in the methods.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the searches required for the different groups are different, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Andres, whose telephone number is 703-305-0557. The examiner can normally be reached on 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 703-308-6564. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

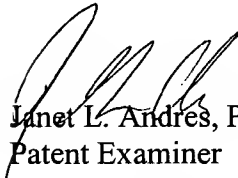


Application/Control Number: 09/995,515

Page 8

Art Unit: 1646

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Janet L. Andres, Ph.D.  
Patent Examiner

March 17, 2003